

that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement....

**Claim 7** was rejected in the Office Action dated June 28, 2010, under 35 U.S.C. § 103(a) as being unpatentable over Kanada, Chen, McDysan, and Jones. The reason for the rejection was that it would have been obvious to one having ordinary skill in the art at the time the invention as made to modify *Westfall* to include the use of packet billing system in order to bill for packets. (See June 28 Office Action, page 7, paragraph 1).

MPEP § 2143 states that the key to supporting any rejection under 35 U.S.C. § 103 is the **clear articulation** of the reason(s) why the claimed invention would have been obvious. Accordingly, the Examiner is required to provide rationale to support a conclusion of obviousness.

Here, the rejection lacked a clear articulation of the reasons why the features of claim 7 would allegedly have been obvious under 35 U.S.C. § 103(a) as being unpatentable over Kanada, Chen, McDysan, and Jones.

Accordingly, because the June 28 Office Action failed to establish a *prima facie* case of obviousness, any rejection of claim 7 in this Office Action, even providing adequate reasoning, is presented for the first time on the record, and, as such, this Office Action should not have been made final.

Further, the Office Action is deficient in numerous aspects and, therefore, Applicants request a new Office Action which addresses the deficiencies.

The outstanding Office Action as well as the preceding Office Action fail to specifically address all of the expressly recited features of the independent **claims 8-15**.

For example, at least the following features of the independent claims are not addressed or mentioned:

**Claim 8:** "Access system ...comprising: (a) a receiving processor-system-part that receives a configuration-signal ... (b) a configuring processor-system-part that ... configures ... said access system and ... said protocol couplings, and (c) a generating/forwarding processor-system part for generating/forwarding a service-information-signal..."

**Claim 10:** “Service-selection-server ... comprising: (a) a receiving processor-system-part that receives a service-selection-signal ..., (b) a configuring processor-system-part that ... generates a configuration-signal and transmits said configuration-signal ..., and (c) a generating processor-system-part that generates a service-information-signal and transmits said service-information-signal...”

**Claim 12:** “Terminal ... comprising: (a) a selecting processor-system-part that generates a service-selection-signal and transmits said service-selection-signal ..., (c) a receiving processor-system-part that receives a service-information-signal ..., and (d) a communicating processor-system-part that communicates with said service-providing-server or said another terminal ...”

**Claim 14:** “Coupling-interface ... comprising: (a) a transceiving processor-system-part that receives a service-selection-signal ..., (c) a receiving processor-system-part that receives a service-information-signal ..., and (d) a communicating processor-system-part that communicates with said service-providing-server or said another terminal ...”

Under the USPTO’s policy, each claim should be reviewed for compliance with every statutory requirement for patentability. (MPEP § 707.07(g)). It is respectfully submitted that the Examiner’s failure to address the explicitly recited features of claims 8-15 constitutes a failure to expeditiously provide the information necessary to resolve issues related to patentability that prevents Applicants from presenting appropriate patentability arguments and/or rebuttal evidence. (See The Official Gazette Notice of November 7, 2003). Additionally, it is submitted that the Examiner’s failure needlessly encourages piecemeal prosecution. (MPEP § 707.07(g)).

And, for this additional reason, Applicants respectfully submit that the outstanding Office Action is improper.

Accordingly, it is respectfully submitted that the finality of the Office Action is premature and the withdrawal of that finality is respectfully requested.

## **II. Claim Rejections**

**A. Claims 1-6 and 8-15** are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kanada, in view of Chen and McDysan.

Initially, Applicants thank the Examiner for clarifying that a user of Kanada corresponds to the claimed terminal and a policy server corresponds to the service-selection-server. (*See* Office Action, page 8, last paragraph - page 9, paragraph 1).

By a way of an overview, **Kanada** is directed to a policy-based control, wherein the network devices are configured for controlling the functions for the Quality of Service (QoS) and security management. A policy server 103 establishes policies. A first policy is converted into second, third policies which are distributed to the network nodes 101, 121. (Paragraphs 37-39).

The first policy acts upon packets generated in clients 141, 142, 143, or 144, or upon packets that come through router 106. The second policy can be distributed to interface 125 of router 121, and the third policy can be distributed to interface 123 or 125 of router 121.

If the first policy works on packets generated in client 145, the second policy can be distributed to interface 124 of router 121, and the third policy can be distributed to interfaces 124 or 123 of router 121. (Paragraph 39).

Accordingly, Kanada describes communications between the client devices of the network.

### ***Preamble***

**Claim 1** recites in the preamble “the terminal is coupled to a coupling-interface able to communicate with the access system by protocol couplings.”

The Examiner states that the preamble is not given a patentable weight unless the limitation is described in the body of the claim. (*See* Office Action, page 9, paragraph 3).

However, pursuant to 2111.02, “[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). “Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).”

In the present case, FIG. 1 of the specification clearly illustrates the terminal coupled to the coupling interface. The coupling interface is coupled to the interface couplings which are coupled to the access system. Therefore, “the terminal is coupled to a coupling-interface able to communicate with the access system by protocol couplings” recited in the preamble limits the structure of claim 1 and must be treated as a claim limitation.

Moreover, the very first paragraph in the specification states “The invention relates to a method for communication between a terminal with a coupling-interface and a providing-server via couplings for providing services defined by service parameters and via an access system for accessing a network.”

Claim 1 recites “transmitting said configuration-signal to said access system for configuring ... said access system and ... said protocol couplings, ... at said terminal and/or said coupling-interface, communicating with said service-providing-server or said other terminal via the protocol coupling.”

Based on these recitations, it is clear that the access system is coupled to the protocol couplings, in order to configure the protocol couplings. Further, the terminal is coupled to the protocol couplings, to communicate with “said service-providing-server.”

Therefore, “the terminal is coupled to a coupling-interface able to communicate with the access system by protocol couplings” recited in the preamble is “necessary to give life, meaning, and vitality” to the claim, and should be construed as if in the balance of the claim.

Accordingly, it is improper for the Examiner to disregard recitations of the preamble of claim 1. It is respectfully requested the Examiner provide support in the cited prior art for the claimed “the terminal is coupled to a coupling-interface able to communicate with the access system by protocol couplings,” or, otherwise, withdraw the rejection of claim 1.

***Configuration-signal of claim 1***

**Claim 1** recites “at said service-selection-server ... generating a configuration-signal and transmitting said configuration-signal to said access system for configuring ... said access system and ... said protocol couplings.”

The Examiner asserts that the claimed access system is connected via the network and that Kanada describes sending the policy change to the policy server and then to the network devices. (*See* Office Action, page 10, paragraph 2).

The relevance of these arguments is not understood. According to claim 1, the configuration-signal is sent to the access system for configuring the protocol couplings.

In Kanada, the policy is sent to the policy receiving section 801 of the server 121. (Paragraphs 37, 70). Interfaces 123, 124, and 125 receive secondary policies. The distributed policies are generated for the packets of the specific client devices. (Paragraph 39).

Accordingly, the policy is not sent to configure the interfaces which are used for communications between the alleged access system and the coupling-interface, as claimed.

Kanada does not teach or suggest at least “transmitting said configuration-signal to said access system for configuring ... said protocol couplings.”

Further, the Examiner appears to rely on Chen as allegedly teaching “transmitting said configuration-signal to said access system for configuring ... said protocol couplings” by disclosing “configuring a multiple protocol mobile station by changing the configurable parameters” (paragraphs 39-40, and 44). (*See* Office Action, page 3, last paragraph).

**Chen** describes a virtual machine interface (VMI) to allow a programmer to configure the mobile station. The hardware of mobile device is configured to work with various communication protocols by changing values of the parameters of table 207. (Paragraphs 9 and 39-40).

Thus, Chen may be teaching changing parameters values to configure the mobile station protocol. However, Chen does not teach or suggest “transmitting said configuration-signal to said access system for configuring ... said protocol couplings,” wherein the protocol couplings are used for communications between the access system and the coupling-interface, as claimed.

The parameters are not the same as or an equivalent of the protocol couplings.

***Service-information signal of claim 1***

**Claim 1** further recites: “at said service-selection-server, generating a service-information-signal and transmitting said service-information-signal to said terminal and/or said

coupling-interface to inform about the configurations..., wherein said service-information signal defines a protocol coupling to be used.”

The Examiner appears to concede that neither Kanada, nor Chen teaches “transmitting said service-information-signal.” The Examiner asserts that McDysan compensates for the deficiencies of these references by describing a reservation confirmation of a policy change. The Examiner also appears to assert that Chen teaches the claimed “service-information signal defines a protocol coupling to be used.” (See Office Action, pages 3, 4, 11).

As discussed above, **Chen** describes configuring hardware of mobile device to work with various communication protocols by changing values of the parameters of table 207. (Paragraphs 39-40). Chen does not teach or suggest “generating a service-information-signal, ... wherein said service-information signal defines a protocol coupling to be used.”

**McDysan** describes initiating the reservation by a customer by sending a message to PAD 40. (Col. 16, line 63 - col. 17, line 5). If the reservation service is authorized for this customer, the message is sent downstream. (Col. 17, lines 6-14). If the reservation is approved at the far end of the network, a reservation (RESV) message is returned. (Col. 17, lines 15-18). If the bandwidth requirements specified by the reservation (RESV) message are authorized for this customer, the reservation is approved. (Col. 17, lines 19-27). The reservation (RESV) message is returned to PAD 40 and to the customer. (Col. 17, lines 30-39).

Accordingly, in the cited portions, McDysan describes a RESV message containing the bandwidth requirements and a confirmation message confirming the reservation (or, as interpreted by the Examiner, confirming the policy change). To the contrary, claim 1 recites “said service-information signal defines a protocol coupling to be used.” That is, the service-information signal informs the terminal and/or the coupling-interface which protocol coupling is to be used. This confirmation message of McDylan is not the same as or an equivalent of the service-information signal which defines a protocol coupling to be used.

Accordingly, Applicants respectfully submit that the proposed Examiner’s combination of Kanada, Chen, and McDysan does not teach or suggest at least “Method for communication between a terminal and a service providing-server or another terminal via an access system ..., wherein the terminal is coupled to a coupling-interface able to communicate with the access

system by protocol couplings, said method comprising ... (a) at said terminal, generating a service-selection-signal and transmitting said service-selection-signal from said terminal to a service-selection-server, (b) at said service-selection-server ... generating a configuration-signal and transmitting said configuration-signal to said access system for configuring ... said access system and ... said protocol couplings, (c) at said service-selection-server, generating a service-information-signal and transmitting said service-information-signal to said terminal and/or said coupling-interface to inform about the configurations made in ... the access system and in ... the protocol couplings, wherein said service-information signal defines a protocol coupling to be used.”

It is, therefore, respectfully submitted that **claim 1 and dependent claims 2-6 and 18** are patentable over Kanada, Chen, and McDysan.

***Claims 8-15***

Rejections of **claims 8-15** are addressed above.

Additionally, **claims 8-15** each recites features similar to those recited in claim 1. Accordingly, **claims 8-15** are patentable at least for the reasons similar to those discussed above regarding claim 1.

**B. Claim 7** is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kanada, Chen, McDysan, and Jones.

Rejection of **claim 7** is addressed above.

Additionally, **claim 7** is patentable at least by virtue of its dependency from claim 1 because Jones does not compensate for any deficiency of Kanada, Chen, and McDysan.

**C. Claim 19** is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kanada, Chen and McDysan in view of Westfall.

**Claim 19** depends from claim 1. Kanada, Chen, and McDysan do not taches all of eth features of claim 1. Westfall does not cure any deficiency of tense references. Accordingly, claim 19 is patentable at least by virtue of its dependency.

**CONCLUSION**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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